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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CORNELIS MARINUS HUIZER

Appeal 2009-005962
Application 10/082,857
Technology Center 2400

Decided: May 24, 2010

Before JOHN A. JEFFERY, JAMES D. THOMAS, and
JAMES R. HUGHES, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-7. Br. 3-7. Claims 1-7, 14, and 15, however, are rejected under a new ground of rejection. Ans. 3-5. Claims 8-13 have been allowed. Ans. 3. We have jurisdiction under 35 U.S.C. § 6(b). Because

Appellant has not responded to the new ground of rejection under 37 C.F.R. § 41.39(b), we dismiss the appeal.

STATEMENT OF THE CASE

Appellant invented an arrangement for embedding extra information into video content. *See generally* Spec. 3.

THE REJECTION

The Examiner newly rejected claims 1-7, 14, and 15 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 3.¹

PRINCIPLES OF LAW

Section 41.39(b) of Title 37 of the Code of Federal Regulations states:

If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte

¹ Throughout this opinion, we refer to the Appeal Brief filed May 21, 2007 and the Examiner's Answer mailed October 19, 2007.

reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

ANALYSIS

Based on the record before us, we must dismiss this appeal on procedural grounds. There is only one rejection in the Examiner's Answer—a new ground of rejection under § 101—and Appellant has simply not responded to that new rejection. That failure to respond is fatal to this appeal.

Notably, the Examiner prominently identified the § 101 rejection as a new ground of rejection. Ans. 3. The Technology Center Director approved the new ground of rejection in accordance with standard procedure.² Ans. 6. The Examiner also unambiguously explained that Appellant *must*, within two months of the mailing date of the Answer (October 19, 2007), exercise one of two regulatory options to avoid *sua sponte* dismissal of the appeal as

² See Manual of Patent Examining Procedure (MPEP) § 1207.03(I), Rev. 3, Aug. 2005 ("MPEP") (noting that a Technology Center Director or designee must approve new grounds of rejection in an Examiner's Answer).

to the claims subject to the new ground of rejection (i.e., claims 1-7, 14, and 15). Ans. 4-5. As the Examiner indicated, Appellant's regulatory options were to: (1) reopen prosecution by filing a reply under 37 C.F.R. § 111, or (2) maintain the appeal by filing a Reply Brief as set forth in 37 C.F.R. § 41.41. *See* 37 C.F.R. § 41.39(b).

Appellant, however, did not respond to the Answer at all, let alone select one of the regulatory options as mandated. That failure to respond is therefore fatal to this appeal under 37 C.F.R. § 41.39(b).

We acknowledge that there is some overlap between the Examiner's final rejection and the new ground of rejection regarding claims 1-7.

Compare Fin. Rej. 3 *with* Ans. 3. That overlap, however, does not otherwise relieve Appellant of the regulatory requirement to respond to the new ground of rejection to avoid dismissal. *See* 37 C.F.R. § 41.39(b).

We therefore find that Appellant failed to avoid *sua sponte* dismissal of the appeal as to claims 1-7, 14, and 15, which are the claims subject to the new ground of rejection. *See* 37 C.F.R. § 41.39(b). Since the remaining pending claims 8-13 have been indicated as allowable (Ans. 3), there is no rejection before us to review. We therefore dismiss the appeal.

CONCLUSION

We dismiss the appeal as to claims 1-7, 14, and 15 which are subject to a new ground of rejection under § 101.

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The Examiner must: (1) cancel claims 1-7, 14, and 15, and (2) notify Appellant that these claims are cancelled because the appeal as to these claims is dismissed. *See MPEP § 1207.03(V)(C).*

ORDER

The appeal is dismissed.

DISMISSED

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